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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 755,633	01 05 2001	Shumin Yang	IM-2-C1-C1	4819

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INTELLECTUAL PROPERTY DEPT.  
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EXAMINER

KAUSHAL SUMESH

ART UNIT PAPER NUMBER

1636

DATE MAILED: 12 17 2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/755,633

Applicant(s)

YANG ET AL.

Examiner

Sumesh Kaushal Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-18 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

## Attachment(s):

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_


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### DETAILED ACTION

► *If the claims are amended, added and/or canceled in response to this office action the applicants are required to follow Amendment Practice under 37 CFR § 1.121 (<http://www.uspto.gov>) and A CLEAN COPY OF ALL PENDING CLAIMS IS REQUESTED.*

#### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- 
- I. Claims 1-13, drawn to isolated nucleic acid molecule, classified in class 536, subclass 23.1.
  - II. Claims ~~14~~<sup>14</sup>-16, drawn to a therapeutic composition and a method to regulate an immune response in an animal using the composition, classified in class 54, subclass 44.
  - III. Claim 17-18, drawn to a method to produce an immunoregulatory protein by culturing a cell, classified in class 435, subclass 41, subclass 69.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the isolated nucleic acid can be used as nucleic acid probes or to make recombinant proteins. Furthermore, the use of the nucleic acid as a therapeutic composition to regulate an immune response requires the use of a genetic vector, which is structurally and functionally different from the use of nucleic acid as a probe or making recombinant protein. In

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In order to be perfectly clear, the following Inventions within the particular Groups are NOT species elections. These are independent and distinct Inventions for the reasons given above and a further election of a single Invention from the elected Group is required.

With regard to Groups I, II and III the independent and distinct Inventions are as follows:

Invention I – nucleic acid not containing a part of SEQ ID NO: 4 and 6

Invention II - nucleic acid not containing a part of SEQ ID NO: 7 and 8

Invention III - nucleic acid not containing a part of SEQ ID NO: 9 and 11

Applicant is required under 35 U.S.C. 121 to elect a single disclosed Invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and the literature and sequence searches for each Group would be divergent from each other Group, so restriction for examination purposes as indicated is proper.

With regard to the different Inventions, the burden of search exists because a different search is required for each separate nucleic acid corresponding amino acid sequences. For example, in order to properly search the isolated nucleic acid of claim 1, 11 and 17, the SEQ ID NO 4 and 6, SEQ ID NO: 5, 7 and 8, and SEQ ID NO:9, 10 and 11 will need to be searched in the computer database maintained by the STIC. In addition, the search would also require searching the canine IL-5 polymorphic forms in Medline, Biosis and Caplus, which may need to be separately reviewed. Potentially, any of these papers could be relevant to the claimed invention. Review of this information would be different for each canine IL5 polymorphic form and would be burdensome,

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the

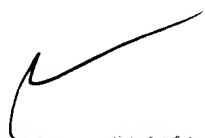
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application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sumesh Kaushal Ph.D. whose telephone number is 703-305-6838. The examiner can normally be reached on Mon-Fri. from 9AM-5PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yucel Irem Ph.D. can be reached on 703-305-1998. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-8724 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

*S. Kaushal*

Patent examiner



JEFFREY FRIEDMAN  
PRIMARY EXAMINER